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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/642,622

08/18/2000

Ryukou Arisawa

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10/31/2003

PEARNE & GORDON LLP

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EXAMINER

GEREZGIHER, YEMANE M

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/642,622

Applicant(s)

ARISAWA ET AL.

Examiner

Yemane M Gerezgiher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6 & 7. 6) ☐ Other:

DETAILED ACTION

1. This application has been examined. Claims 1-5 are pending.

Drawings

2. The drawings are objected to because the drawings contain a foreign language, which should be removed/replaced in this application with an English language.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu et al (U.S. Patent Number 6,587,684) hereinafter referred to as Hsu in view of Tagawa et al (U.S. Patent Number 6,351,442) hereinafter referred to as Tagawa and further in view of applicant's admission.

Regarding claims 1-5, Hsu disclosed a digital wireless telephone system downloading software to a digital mobile station (cell phone) comprising a storage

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medium, where the system included a server having applications to be downloaded to the portable phone. Hsu disclosed mobile user sending request messages to a destination server (claim 3) to establish a session between the digital telephone and the server for downloading new and update software applications related to the digital telephone service. See abstract and Fig 7 and 9. Hsu disclosed a "digital wireless telephone configured for recovering an executable program selected by the user and associated with digital telephone services from a stream of wireless data packets received from a digital wireless telephone network, and storing the executable program in a nonvolatile memory (claim 5) for execution by the digital wireless telephone where a digital wireless telephone is configured for sending selection inputs supplied by a user to a server via a digital wireless communications system, and receiving downloaded software from the server based on the selection inputs". See col.3, Lines 54-67. Hsu disclosed a portable phone downloading, storing application software in the storage medium of the portable phone and executing the multiple downloaded software which interact by exchanging network messages across API (application programming Interface). See col.4, Lines 17-54. Hsu showed a client browser executable by the portable telephone enabling the mobile phone user to navigate a network to select the downloading of different software applications as they are made available on the server that are executable by the digital portable telephone (see col.4, lines 55-67) such as operating system, cell processing software and many more applications selected based on the mobile user's desired selections. See col.5, Lines 1-20.

However, Hsu did not explicitly teach downloading music data and application software in order to play music data on portable telephone.

Tagawa disclosed a music reproduction apparatus where a mobile user was sending a download request to a server for downloading a desired music data (see col.9, lines 57-67) and a controller controlling history of the recording operations by determining whether or not a music data has already been recorded (claim 2) on the recording medium. See col.7, lines 62-67. Tagawa disclosed different music compression applications including MP3 and AAC (advanced audio coding). See col.9, lines 50-57.

The inventive entity admitted that a mobile user remotely selecting/listening music data and application software from a server through a communication network was known in the art (Japanese Patent Publication No. Hei.11-164058). See specification, background of the invention, second paragraph.

An artisan who was aware of remotely selecting/listening a music data from a remote server via a portable telephone would have been motivated to look for teachings that may have allowed a user to select or specify a music data to be downloaded and reproduced among a large number of music data and to specify the reproduction order of the selected music data smoothly. See Tagawa col.3, lines 30-35. And further to look for teachings that may have allowed downloading data and software application (executable program on a mobile station) and data associated with the software application, because "the user may customize his or her digital telephone programming based on the desired services. Moreover, the invention enables use of an open platform

for digital wireless communications, enabling application developers to develop new software applications for new digital telephone services. Digital telephone users can then download the new software applications as they are made available on a server”
See Hsu col.5, lines 12-19.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the admitted teaching related to remotely selecting/listening of a music data on a portable telephone with the teachings of Tagawa related to downloading a music data and have modified Hsu related to downloading data and software applications that are executable on the portable telephone to download application software such as MP3 or other types of compressions in order to selectively download and play music on the mobile phone by executing suitable music application software on the mobile device.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

- a. Cook et al (U.S. Patent Number 6,577,614) disclosed downloading new applications to the mobile client.
- b. Imura, Shigeru (U.S. Patent Number 6,513,719) disclosed a semiconductor storage device and operation setting method of the same where a user was downloading a music data and reproducing the downloaded music data using a small memory stick having excellent vibration proof recording medium.

- c. Hall et al. (U.S. Patent Number 6,356,543) disclosed controlling a mobile phone system user views from the web where a processor in the mobile phone installs the downloaded application software in the phone (for example, the application software being executed in the mobile phone can comprise an operating system with JAVA TM functionality).
- d. Schaal et al. (U.S. Patent Number 6,333,928) disclosed integrated multimedia telecommunications server.
- e. Birgeron, Joakim (U.S. Patent Number 6,138,009) disclosed a system and method for customizing wireless communication unit downloading basic functionality software to a generic mobile station handling means for program execution in the memory storage of the mobile station.
- f. Valentine et al. (U.S. Patent Number 6,018,654) disclosed a method and apparatus for downloading tones to mobile terminals allowing a mobile user to request downloading of a tone data from a mobile network through a communication-less communication link.
- g. France et al. (U.S. Patent Number 5,734,119) disclosed a method for streaming transmission of compressed music.
- h. Goodman, William (U.S. Patent Number 5,594,779) disclosed a mobile audio program selection system using a public switched telephone network

FOREIGN PATENT DOCUMENT

- i. TADA, YUKIO (JP 2001016366 A) disclosed download system for portable music player, downloads music data stored in read only memory and

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transmits selected music data to personal computer of download unit where it's advantage is to simplify operation of downloading a music data.

j. Honma, Hiroki (JP 09331288 A) disclosed an intermittent reception system and mobile communication station in order to efficiently utilize electric power at a mobile communication station by recording the incoming call history.

k. Shibata et al. (JP 08163640 A) disclosed recording history of mobile terminal activities in a moving body termination transfer system.

NON PATENT DOCUMENTS

l. Imrich Chlamtac et al, "Mobile Computing: Challenges and Potential", Encyclopedia of Computer Science, 4th Edition, international Thomson Publishing, 1998

6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is 703-305-4874. The examiner can normally be reached on Monday- Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, David A. Wiley, can be reached at 703-308-5221.

Yemane Gerezgiher
Patent Examiner
AU 2142

October 20, 2003

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER